

1 The opinion in support of the decision being entered today is *not* binding
2 precedent of the Board.

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4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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11 *Ex parte* DIANE R. HAMMERSTAD

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14 Appeal 2007-2241
15 Application 09/768,990
16 Technology Center 3600

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19 Decided: August 15, 2007

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22 Before, WILLIAM F. PATE, III, HUBERT C. LORIN, and
23 LINDA E. HORNER, *Administrative Patent Judges*.

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25 LORIN, *Administrative Patent Judge*.

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27 ORDER REMANDING TO THE EXAMINER

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29 This appeal is from a decision of the Examiner rejecting claims 1-6
30 and 9-13¹ under 35 U.S.C. § 103(a) (2002) as obvious over Alberts (US
31 Patent No. 5,937,392) in view of Tso (US Patent No. 6,047,327) in view of
32 Batachia (US Patent Application Publication 2002/0082912). 35 U.S.C.
33 § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ Claims 7, 8, 14-16 have been canceled.

1 We find that the appeal is not in condition for a decision. This
2 application is remanded to the Examiner to address the matters specified
3 below and to take action deemed appropriate.

4 The Appeal Brief (filed May 9, 2006) and Answer (mailed Jun. 14,
5 2006) define the issue as whether an affidavit Appellant filed under
6 37 C.F.R. § 1.131 (filed Dec. 12, 2005) is sufficient to demonstrate prior
7 invention by Appellant and thereby render Batachia legally unavailable as
8 prior art under 35 U.S.C. § 102(e). Given that Appellant has not been
9 afforded an opportunity to overcome deficiencies in the 131 affidavit, it is
10 premature for the Board to decide this issue.

11 Batachia was first introduced as prior art and applied, in combination
12 with Alberts and Tso, against the claims under 35 U.S.C. § 103(a) in the
13 Final rejection (mailed Oct. 31, 2005). Appellant responded to the Final
14 rejection with an affidavit (Dec. 12, 2005) pursuant to 37 C.F.R. § 1.131 to
15 evidence prior invention in an attempt to render Batachia legally unavailable
16 as prior art under 35 U.S.C. § 102(e). An Advisory action then issued
17 (mailed Dec. 22, 2005) indicating that the 131 affidavit was ineffective to
18 overcome Batachia because, according to the Examiner, Batachia was
19 legally available as prior art under 35 U.S.C. § 102(b). The Advisory Action
20 also included a discussion briefly explaining that the 131 affidavit was
21 deficient for failing to show prior reduction to practice, conception, and
22 diligence. During a subsequent interview (held Feb. 1, 2006; recorded in the
23 Interview Summary, mailed Feb. 17, 2006), the Examiner agreed that
24 Batachia did *not* qualify under 35 U.S.C. § 102(b), thereby conceding that
25 Batachia qualified as prior art under 35 U.S.C. § 102(e). The Examiner
26 repeated, again briefly, that the 131 affidavit was deficient for failing to

1 show prior reduction to practice, conception, and diligence. Appellant then
2 filed a Notice of Appeal (filed Feb. 2, 2006) accompanied by a Pre-Appeal
3 Brief Request for Review (filed Feb. 2, 2006), which included this passage:

4 The claims have been finally rejected under 35 USC 103(a) as
5 being unpatentable over three references, one of which Applicant
6 contends is not prior art. In response to the final Office Action,
7 Applicant filed an affidavit under 37 CFR 1.131 and provided an
8 internal company invention disclosure form as evidence of an early
9 internal disclosure of Applicant's invention. Examiner's Advisory
10 Action of 12/22/05 misstates the period of time between the priority
11 date of Applicant's application and the priority date of the relied-upon
12 reference. Examiner's Advisory Action of 12/22/05 further misstates
13 the requirements regarding diligence. Examiner's Advisory Action of
14 12/22/05 is missing an explanation of a deficiency in the showing of
15 the conception of Applicant's invention. Examiner's Advisory Action
16 of 12/22/05 is further missing an explanation of the lack of showing of
17 the alleged reduction to practice.

18 Pre-Appeal Brief Request for Review, p. 1. A Pre-Appeal Conference was
19 held and the panel determined, without further comment, that the rejection of
20 claims 1-6 and 9-13 should proceed to the Board. The panel did not provide
21 further explanation of the deficiencies of the 131 affidavit as had been
22 requested by Appellant in the Pre-Appeal Brief Request for Review (see
23 passage reproduced above). See the Notice of Panel Decision from Pre-
24 Appeal Brief Review, mailed Feb. 17, 2006. Appellant then filed the Appeal
25 Brief (filed May 9, 2006; a prior-filed Appeal Brief was determined to be
26 defective) devoted entirely to reasons why Appellant believed the 131
27 affidavit was sufficient to show prior invention. Then, for the first time, in
28 the subsequent Examiner's Answer (mailed Jun. 14, 2006), a full
29 explanation as to why the 131 affidavit fails to evidence prior invention was
30 provided. Pp. 11-15.

1 In our view, the full explanation as to why the 131 affidavit fails to
2 evidence prior invention should have been communicated to Appellant
3 *before* the Examiner's Answer. In providing this full explanation *after*
4 Appellant filed his Appeal Brief, Appellant was not afforded an opportunity
5 to fully understand the Examiner's objections and make, if needed, the
6 appropriate supplementation of the evidence presented. Upon remand, if the
7 rejection is maintained and Batachia remains included as a prior art
8 reference against the claims, the Examiner should re-evaluate the 131
9 affidavit and, if it is still determined to be deficient, communicate a full
10 explanation of the deficiencies to Appellant and afford Appellant an
11 opportunity to respond.

12 Because the issue has been narrowly defined as whether the 131
13 affidavit is sufficient to demonstrate prior invention, it suggests that the
14 Examiner and Appellant have agreed that the combination of Alberts and
15 Tso would not render the claimed subject matter obvious to one of ordinary
16 skill in the art. Though this is never made clear on the record, this suggestion
17 is buttressed by the fact that Appellant has repeatedly expressed that he
18 understands the Examiner to be taking the position that only with the
19 additional teachings of Batachia is the combination of Alberts, Tso, and
20 Batachia capable of making obvious claims 1-6 and 9-13,² to which the
21 Examiner has never responded and thus never denied.

² "Appellant concludes that Examiner believes only with the addition of the additional teachings of Batachia is the combination of Alberts, Tso, and Batachia capable of making obvious claims 1-6 and 9-13." Appeal Br. 6. Similar statements were made in the Amendment After Final (filed Dec. 12, 2005, p. 3) responding to the Final Rejection and the Pre-Appeal Brief Request for Review (filed Feb. 2, 2006, p. 2).

1 We observe that Appellant's understanding of the Examiner's position
2 is rooted in part in a vague statement made in the Final Rejection that has yet
3 to be clarified. The Examiner issued an Office action (mailed May 20,
4 2005) rejecting (a) claims 1-8 under 35 U.S.C. §101 and (b) claim 1-16
5 under 35 U.S.C. §103(a) over Alberts in view of Tso. Appellant filed a
6 response (Sep. 26, 2005) including an amendment to claim 1. The
7 amendment to claim 1 is reproduced below:

8 1. A method of delivering content and time significant advertising
9 from a server to a subscriber comprising the steps of:
10 accepting a subscriber profile including an advertising preference
11 and a time of delivery preference profile;
12 storing said subscriber ~~advertising~~ profile at the server;
13 determining an attribute of and a time significance for an
14 advertisement;
15 recalling at the server said stored subscriber advertising preference
16 profile;
17 comparing said subscriber advertising preference profile to said
18 attribute;
19 determining a current time of the subscriber;
20 comparing said current time to said significance; ~~and~~
21 including said advertisement with the content at the server when
22 said current time matches said time significance and said subscriber
23 advertising profile matches said attribute; and
24 delivering the content and said included advertisement from the
25 server to the subscriber when said current time determination matches
26 said time of delivery preference.

27 The Examiner then issued a Final rejection (mailed Oct. 31, 2005) stating:
28 "The amendment filed on 9/26/05 is sufficient to overcome *the prior*
29 *rejection*. A new reference [i.e., Batachia] has been added to the 35 USC 103
30 rejection" (p. 2). The Final rejection (p. 2) then restates the grounds of
31 rejection to read that claims 1-6 and 9-13 are rejected under 35 U.S.C.
32 § 103(a) over Alberts in view of Tso in view of Batachia, the rejection now

1 under appeal. The Examiner has never explained which of the two rejections
2 set forth in the prior Office action was determined to be overcome by the
3 amendment. The statement in the Final Rejection that the amendment was
4 sufficient to overcome *the prior rejection* is sufficiently unclear that the
5 possibility exists that the Examiner determined the amendment to be
6 sufficient to overcome the prior 103 rejection.

7 Assuming this is the case, we are of the view that the Examiner should
8 step back and re-assess the patentability of the claims over Alberts and Tso
9 in light of the principles on the law of obviousness recently articulated in
10 *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). To
11 assist the Examiner, we make the following comments, using claim 1, *supra*,
12 as representative of the claims on appeal.

13 Alberts discloses delivering time-significant advertising content to
14 users over a network, such as the internet.

15 Alternatively, an advertiser may want a concentration or
16 intensification of ads at particular times, perhaps in response to a
17 profile of users, e.g., different times for children versus adults, or for
18 people accessing the site from home versus work.

19 Col. 1, ll. 43-48. Alberts uses an advertising database on a database engine
20 (which communicates with an ad server to serve up an ad in response to a
21 request made by a user on the internet; col. 3, ll. 18-28, Fig. 1) that contains
22 tables with “information indicating parameters for the display of ads” (col. 3,
23 ll. 31-33) that can include “stop/start information for when the ad is to run”
24 (col. 3, ll. 41-42). The information, such as stop/start information, that is
25 used to trigger the delivery of an ad is determined based on statistics the ad
26 server receives on how often ads are served and how often viewers click on
27 them (Alberts, col. 4, ll. 4-26).

1 Alberts differs from the claimed method in that the triggering
2 information the claimed method uses comes from information provided in a
3 subscriber profile rather than, as with Alberts, statistics taken from the
4 behavior of users accessing websites.

5 Tso discloses sending information over a network to a user depending
6 on information contained in a user profile.

7 What information is sent to the user is dependent on various factors,
8 including: the location of the user; the time of day; and *the*
9 *information contained in a user profile.*

10 Col. 1, ll. 48-52. Tso uses a system which comprises a server (called an
11 “InfoCast” server) connected to a network that contains a “subscriber
12 database at the user’s home” (col. 4, ll. 38-41; referred later in Tso as
13 “subscriber database 53”) and an “InfoBite” database (element “50,” col. 4,
14 l. 44; “InfoBite” is information sent in lieu of the full item, see col. 7, ll. 30-
15 40), and a schedule/resource controller (element “61”).

16 Schedule/resource controller 61 is responsible for filtering the
17 InfoBites that are sent to a user based upon the user’s profile as
18 contained in the user’s record and subscriber database 53 - i.e., a
19 subscriber profile filter, the user’s current location - i.e., a locational
20 filter, and the time of day - i.e., a temporal filter.

21 Col. 10, ll. 41-46. This passage appears to teach the delivery of content
22 filtered on the basis of information, such as the time of day, contained in a
23 subscriber profile.

24 Given the teachings of Alberts and Tso, we ask the Examiner to
25 consider whether it would have been obvious to one of ordinary skill in the
26 art to deliver time-significant advertising content to a subscriber over a
27 network triggered by information contained in a subscriber’s profile. While
28 neither Alberts and Tso explicitly show comparing the current time with the

1 time specified in the subscriber profile as a prerequisite to delivering content
2 in accordance with the subscriber's specified time, the Examiner should
3 consider whether such a step would be inherent to any method, such as the
4 one Tso describes, that seeks to deliver time-significant content based on the
5 time of day specified in a subscriber's profile. *Unless* such a comparison
6 were first to be made, a subscriber would never be guaranteed receipt of
7 content at the time specified in his/her profile. "The obviousness analysis
8 cannot be confined by ... overemphasis on the importance of published
9 articles and explicit content of issued patents" *KSR*, 127 S.Ct. at 1740,
10 82 USPQ2d at 1396.

11 Upon remand, the Examiner should reconsider whether the claimed
12 subject matter would have been obvious over Alberts and Tso. If after
13 reconsideration the Examiner determines that the addition of Batachia is
14 necessary to reject the claims for obviousness, the Examiner should make
15 that clear on the record. At that point, the sufficiency of the 131 affidavit
16 should be re-evaluated and, if it is still determined to be deficient, a full
17 explanation of the deficiencies should be communicated to Appellant, with
18 Appellant being given an opportunity to respond.

19 This remand to the examiner pursuant to 37 CFR § 41.50(a)(1)
20 (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286
21 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further
22 consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a
23 supplemental examiner's answer is written in response to this remand by the
24 Board.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
§ 1.136(a)(1)(iv) (2006).

REMAND

JRG

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